

**Amendment and Response**

Applicant: Steve O. Rasmussen et al.

Serial No.: 10/616,809

Filed: July 10, 2003

Docket No.: 10012978-2

Title: STARTWHEEL ACTUATION TIMING FOR PRINT MEDIA TRANSPORT SYSTEM AND METHOD

**REMARKS**

The following Remarks are made in response to the Non-Final Office Action mailed April 23, 2004, in which claims 46-62, 64, 66-90, and 92 were rejected and claims 63, 65, and 91 were objected to. With this amendment, claims 93-104 have been added, claims 46, 58, 68, 78, 83, and 86 have been amended to clarify Applicant's invention, and allowable claims 63, 65, and 91 have been rewritten in independent form. Claims 46-104, therefore, remain pending in the application and are presented for reconsideration and allowance.

**Claim Rejections under 35 U.S.C. § 112**

Claims 55, 64, and 75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, claims 55, 64, and 75 are rejected under 35 U.S.C. 112, second paragraph, on the basis that it is unclear how long the length of the trailing end portion of the print media is.

Applicant respectfully traverses this rejection and submits that it is clear from each of these claims that a length of the trailing portion of the print media is defined to be less than a circumference of the starwheel.

In view of the above, Applicant submits that claims 55, 64, and 75 are clear and are in a condition for allowance. Applicant, therefore, respectfully requests that the rejection of claims 55, 64, and 75 under 35 U.S.C. 112, second paragraph, be reconsidered and withdrawn and that claims 55, 64, and 75 be allowed.

**Claim Rejections under 35 U.S.C. § 102**

Claims 46-62, 64, 66-90, and 92 are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshimura et al. U.S. Patent No. 5,818,487.

With this Amendment, independent claims 46, 58, and 78 have been amended to clarify that the starwheel is prevented from contact with the drive roller, and independent claims 68, 83, and 86 have been amended to clarify that selectively actuating the starwheel includes preventing contact between the starwheel and the drive roller.

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With respect to the Yoshimura et al. patent, this patent does not teach or suggest a print media transport assembly as claimed in independent claim 46, a printing system as claimed in independent claim 58, a method of advancing a print media as claimed in independent claim 68, a print media transport assembly as claimed in independent claim 78, a method of advancing a print media as claimed in independent claim 83, nor a method of printing as claimed in independent claim 86 wherein the starwheel is prevented from contacting the drive roller.

For example, the Yoshimura et al. patent discloses that when the paper-discharging roller unit 112 is at the paper-discharging position, the paper-discharging roller 131 is urged against the drive roller 126 (col. 5, lines 49-58). In addition, operation of the paper-transporting mechanism of the Yoshimura et al. patent teaches that with the paper 138 at the print-initiating position P1 (Fig. 7), the drive circuit 157 causes the roller selecting motor 156 to switch the paper-discharging roller unit 113 to the paper-discharging position (col. 6, lines 49-55). At the print-initiating position P1 of the Yoshimura et al. patent, however, the paper 138 is not positioned between the paper-discharging roller 131 and the drive roller 126 (see; e.g., Fig. 7). As such, the paper-discharging roller 131 of the Yoshimura et al. patent contacts the drive roller 126 (Fig. 7). Thus, the paper-discharging roller 131 of the Yoshimura et al. patent is not prevented from contact with the drive roller 126.

In view of the above, Applicant submits that independent claims 46, 58, 68, 78, 83, and 86 are each patentably distinct from the Yoshimura et al. patent and, therefore, are in a condition for allowance. Furthermore, as dependent claims 47-57 further define patentably distinct claim 46, dependent claims 59-62, 64, 66, and 67 further define patentably distinct claim 58, dependent claims 69-77 further define patentably distinct claim 68, dependent claims 79-82 further define patentably distinct claim 78, dependent claims 84-85 further define patentably distinct claim 83, and dependent claims 87-90 and 92 further define patentably distinct claim 86, Applicant submits that each of these dependent claims are also in a condition for allowance. Applicant, therefore, respectfully requests that the rejection of claims 46-62, 64, 66-90, and 92 under 35 U.S.C. 102(b) be reconsidered and withdrawn and that claims 46-62, 64, 66-90, and 92 be allowed.

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**Allowable Subject Matter**

Claims 63, 65, and 91 are objected to as being dependent upon a rejected base claim and are indicated as being allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

Applicant agrees with the Examiner's conclusions regarding patentability without necessarily agreeing with or acquiescing in the Examiner's reasoning. In particular, Applicant submits that the above-identified claims are allowable because the prior art fails to teach, anticipate or render obvious the invention as claimed, independent of how the invention is paraphrased.

With this Amendment, Applicant has rewritten allowable claim 63 in independent form to include all of the limitations of the base claim (claim 58) and any intervening claims (claim 61). In addition, Applicant has added new claims 93-97 to depend from rewritten independent claim 63. As rewritten claim 63 is now believed to be in allowable form, Applicant respectfully submits that dependent claims 93-97 are allowable in dependent form. Applicant, therefore, respectfully requests that the objection to claim 63 be withdrawn and that claims 63 and 93-97 be allowed.

With this Amendment, Applicant has rewritten allowable claim 65 in independent form to include all of the limitations of the base claim (claim 58) and any intervening claims (none). In addition, Applicant has added new claims 98-101 to depend from rewritten independent claim 65. As rewritten claim 65 is now believed to be in allowable form, Applicant respectfully submits that dependent claims 98-101 are allowable in dependent form. Applicant, therefore, respectfully requests that the objection to claim 65 be withdrawn and that claims 65 and 98-101 be allowed.

With this Amendment, Applicant has rewritten allowable claim 91 in independent form to include all of the limitations of the base claim (claim 86) and any intervening claims (claim 87). In addition, Applicant has added new claims 102-104 to depend from rewritten independent claim 91. As rewritten claim 91 is now believed to be in allowable form, Applicant respectfully submits that dependent claims 102-104 are allowable in dependent form. Applicant, therefore, respectfully requests that the objection to claim 91 be withdrawn and that claims 91 and 102-104 be allowed.

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**CONCLUSION**

In view of the above, Applicant respectfully submits that pending claims 46-104 are all in a condition for allowance and requests reconsideration of the application and allowance of all pending claims.

Any inquiry regarding this Amendment and Response should be directed to either Robert D. Wasson at Telephone No. (360) 212-2338, Facsimile No. (360) 212-3060 or Scott A. Lund at Telephone No. (612) 573-2006, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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Respectfully submitted,

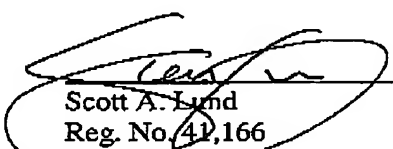
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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being facsimile transmitted to the United States Patent and Trademark Office, Fax No. (703) 872-9306 on this 22<sup>nd</sup> day of July, 2004.

By   
Name: Scott A. Lund